

### REMARKS

In response to the non-final Office Action of March 23, 2007, applicants ask that all claims be allowed in view of the amendment to the claims and the following remarks. Claims 1-20 are now pending in the application, with claims 1, 19, and 20 being independent.

#### **Claim Rejections Under 35 U.S.C. § 102**

Claims 1, 3, 4-6, 19, and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,247,043 (Bates). Applicants request reconsideration and withdrawal of this rejection because Bates does not describe or suggest all of the subject matter recited in independent claims 1, 19, and 20, as described more fully below.

As amended, independent claim 1 recites a method for enabling management of contacts that includes passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member, based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group, enabling the member to associate a name with the contacts list, and enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contacts list.

While Bates describes managing contacts in electronic messaging systems, Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, and generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group, based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1.

The Office Action contends that Bates' disclosure at column 18, lines 55-66 of automatically creating a new electronic messaging group based upon the addressing of an

electronic message amounts to a disclosure of passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, as recited in independent claim 1. See Non-final Office Action of March 23, 2007 at page 2, lines 12-13. However, Bates' disclosure of automatically creating a new electronic messaging group based upon the addressing of an electronic message does not teach passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, as recited in independent claim 1, nor does Bates' disclosure teach generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group, based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as also recited in independent claim 1. In contrast, Bates describes automatically creating a new electronic messaging group based on recipient addresses included in a single message:

[E]lectronic messaging groups may be created and/or updated based upon the addressing of an electronic message created by a local user.

The automated creation of new electronic messaging groups may be implemented in the illustrated embodiment in part in send/receive message routine 112 by calling a maintain groups routine 166 after each message is sent by the mail application. One suitable implementation of maintain groups routine 166 is illustrated in greater detail in FIG. 16. Routine 166 begins in block 250 by building a message group from the list of addresses for the message that was just sent.

Bates at col. 18, lines 55-66 (emphasis added); see also Bates at col. 4, lines 16-19 ("an electronic message is addressed to a plurality of recipient users in response to user input, and a new electronic messaging group is automatically created including the plurality of recipient users.") (emphasis added).

Because Bates describes automatically creating a new electronic messaging group based on recipient addresses included in a single message, it follows that Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, and generating a contacts list that includes the set of contacts and

that is useful in addressing future communications to the set of contacts as a group, based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claim 1 and its dependent claims, claims 3 and 4-6.

As amended, independent claims 19 and 20 recite features that are similar to those discussed above in connection with independent claim 1, and do so in the context of an apparatus (claim 19) and a system (claim 20). Accordingly, applicants request reconsideration and withdrawal of the rejection of independent claims 19 and 20 for at least the reasons discussed above in connection with independent claim 1.

### **Claim Rejections Under 35 U.S.C. § 103**

Dependent claims 7-14 and 17, each of which depends from independent claim 1, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bates in view of U.S. Patent No. 6,678,719 (Stimmel). Stimmel describes systems and techniques for enabling a user to determine the availability of another user and for enabling the user to identify communications procedures for contacting the other user based on the other user's availability. See Stimmel at Abstract. However, Stimmel does not cure the deficiencies in Bates noted above in connection with independent claim 1, nor does the Office Action contend that Stimmel does so. Accordingly, at least because of their dependencies and the reasons discussed above in connection with independent claim 1, applicants request reconsideration and withdrawal of the rejection of dependent claims 7-14 and 17.

Dependent claim 2, which depends from independent claim 1, has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bates in view of U.S. Patent No. 6,134,582 (Kennedy). Kennedy describes a system for managing electronic mail messages in a client-server environment that includes a database, stored at the client, that maintains a central archive of message-related information in connection with messages located on the server and that supports current and future message communication operations between the client and the server.

See Kennedy at Abstract. However, Kennedy does not cure the deficiencies in Bates noted above in connection with independent claim 1, nor does the Office Action contend that Kennedy does so. Accordingly, at least because of its dependency and the reasons discussed above in connection with independent claim 1, applicants request reconsideration and withdrawal of the rejection of dependent claim 2.

Dependent claims 15 and 16, each of which depends from dependent claim 14, which itself depends from independent claim 1, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bates in view of Stimmel further in view of Kennedy. However, Kennedy does not cure the deficiencies in Bates and Stimmel noted above in connection with dependent claim 14 and independent claim 1, nor does the Office Action contend that Kennedy does so. Accordingly, at least because of their dependencies and the reasons discussed above in connection with dependent claim 14 and independent claim 1, applicants request reconsideration and withdrawal of the rejection of dependent claims 15 and 16.

Dependent claim 18, which depends from dependent claim 14, which itself depends from independent claim 1, has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bates in view of Stimmel further in view of U.S. Patent No. 7,032,007 (Fellenstein). Fellenstein describes a mechanism by which transcripts of instant messages may be generated and analyzed to determine if inappropriate contact with unapproved users is occurring. See Fellenstein at Abstract. However, Fellenstein does not cure the deficiencies in Bates and Stimmel noted above in connection with dependent claim 14 and independent claim 1, nor does the Office Action contend that Stimmel does so. Accordingly, at least because of its dependency and the reasons discussed above in connection with dependent claim 14 and independent claim 1, applicants request reconsideration and withdrawal of the rejection of dependent claim 18.

## **Conclusion**

Applicants submit that all claims are in condition for allowance.

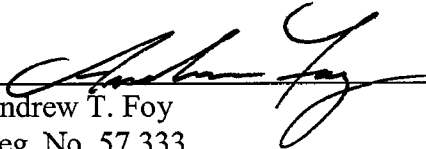
It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession

of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The fee in the amount of \$120 in payment of the Petition for One Month Extension of Time is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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